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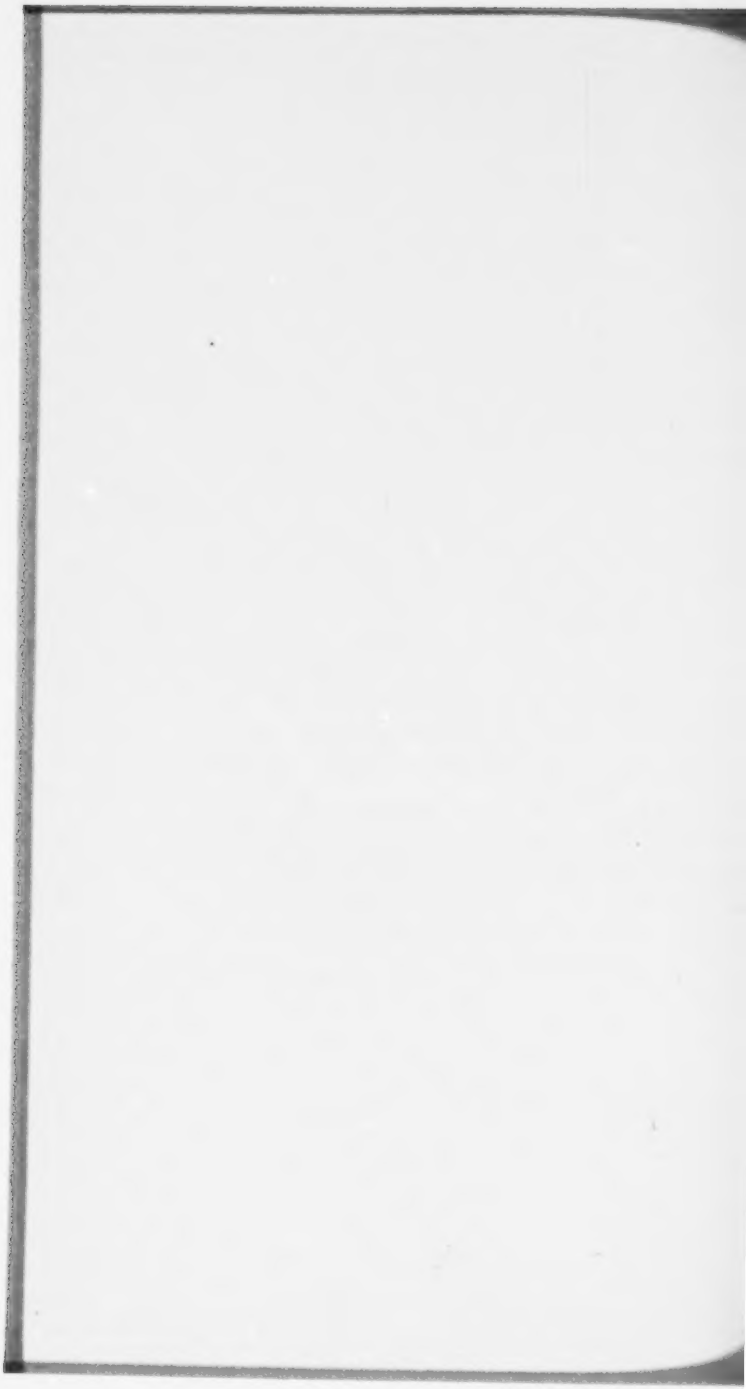

SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, A. D. 1901.

KOKOMO FENCE MACHINE COMPANY, *Petitioner*,
vs.
ALVA L. KITSELMAN AND DAVIS M. KITSELMAN, *Respondents*.

On Application for Writ of Certiorari.

BRIEF FOR RESPONDENTS IN OPPOSITION TO PETITION.

STATEMENT.

Respondents here (complainants and appellants below) submit that the petition shows no cause for the intervention of this court; that no error adverse to the petitioner has been committed; that the petition does not show or suggest that there is any question of peculiar gravity and general importance for review, or any conflict between the decision of the court of appeals and the decisions of other circuits, or even charge that the court erred in matter of law or that the petitioner has suffered or is liable to suffer substantial damage, hardship or inconvenience; that it, in effect, concedes that the opinion of the court of appeals correctly states the law as administered by this court, and merely complains that in applying this law to the disputed questions of fact, which had to be determined upon the voluminous record and numerous exhibits before it, the court found these facts against the petitioner; that the decision complained of relates only to an interlocutory decree under a patent which expires in about two years, under which it is not pretended that any other litigation is pending; that the petition does not represent that the defendant has manufactured, used or sold the infringing device in such numbers as to involve damages in any considerable amount, or that it was, at the time of the decision, manufacturing, using or selling, or intending to manufacture, use or sell, the infringing device, or that it will be in any

wise prejudiced by the injunction, or that the petitioner asked to have any question of law certified to this court; that the petition is trivial, and that it ought to be denied.

It does appear that the petitioner is a corporation, having a nominal capital of $6,000, organized at the time it commenced this infringement by men who had been employed by the complainants, or about their plant where the patented machines were being manufactured and sold, and with full knowledge of the liability which they incurred; that notice was given as soon as the infringement began, and suit promptly commenced; that the complainants, to whom the patent in controversy was granted, have been since the date of the invention the exclusive manufacturers of the patented machine, having built up a large industry therein; that their rights have been universally respected, except some trifling infringements which were immediately stopped by notice or by injunction; that the Kitselman invention not only introduced the first machine containing the organization covered by the claims of the patent, and employed under some disguise of outline by the defendants, but also the first machine ever devised capable of weaving wire-mesh fence along the posts upon which it was to be permanently supported, so as to impart to and preserve in the fence the rigidity due to the maintenance of the tension applied in the weaving of the successive meshes; that it not only enabled the farmers to weave their own fence at their leisure, but enabled them to construct a fence possessing substantial advantages over any fence that had been procurable from any source before; that in addition to being adapted to purposes which no prior machine served, the machine also possessed special advantages over any prior machine for the purpose of making fence of a similar character to that made by such prior machines; that its peculiar capacities were not obtainable by any changes in prior machines short of rejecting the entire plan of their construction and reorganizing them upon the Kitselman plan; that the infringement (which was engineered by those who had peculiar opportunities for becoming acquainted with the patented machine) adopted, element by element, in substantially similar combination, the members constituting the patented machine and embraced in the claims in controversy; that none of the changes made in these elements, or in the incidental mechanism of the machine, either deprived them of their essential character or changed materially their mode of operation or their relations to each other; that the circuit court of appeals, after hearing argument and receiving printed briefs, held the case under advisement for many months, and, with the mechanical exhibits before it, has found the facts to be such as to justify the injunction and the reference to the master for an account; that while it is true that one of the circuit judges has noted his dissent to the action of the court, he has not stated his reasons for such dis-

sent, and it does not appear on what ground he dissented, or that his dissent was due to anything more than a general disinclination to concur in the law of patents as administered by the supreme court. If that dissent had been due to more substantial reasons they would probably have been expressed in a dissenting opinion, for the learned judge, who seldom concurred in any opinion in favor of complainant in a patent suit, was in the habit of stating strongly his reasons for an adverse opinion whenever he was satisfied that the conclusions of the majority were not in harmony with the controlling authorities. In two other patent cases decided the same day, the same judge is noted as dissenting. In one of them (*Justi* v. *Clark*, 108 Fed. Rep., 659) he delivered a dissenting opinion indicating that he could not recognize as an element of the invention *the new conception which originated and governed the structure of the patented device*, but judged the invention solely with reference to the question whether, *after the plan was conceived of and the utility of the new device discovered*, it required more than ordinary mechanical skill to adapt the elements of old devices intended for a different purpose to co-operate in such manner as to constitute the new device. In the second of these (*Johnson* v. *McCurdy*, 108 Fed. Rep., 671) he noted his dissent, but admitted that he was not clear that the conclusion of the majority was wrong. In the present case he simply noted his dissent without intimating upon what it was based.

The petition proceeds on the assumption that because the petitioner is dissatisfied with the conclusion of the circuit court of appeals on a question of infringement arising under an appeal from an interlocutory decree, where two of the judges of the court of appeals have overruled the court below in their finding of fact (the third judge dissenting from the opinion, but not stating on what grounds), this court should intervene by *writ of certiorari*, though it is not even alleged that the court has misconceived the law, or that there has been any dispute of law between the several judges, or that the matter in controversy has any exceptional importance or concerns any public or general interest or affects anything beyond the relief here given, or that the judgment complained of inflicts substantial damage or special hardship on the petitioner. It does not charge that the court of appeals misstated or misapprehended the law in any respect, but complains of its conclusion of fact by which the evidence before it was held to bring defendant within a well-settled rule of law. It, in effect, seeks a review of the finding of the court upon disputed questions of fact. It cannot impugn the rule of law stated in the opinion of the court of appeals as governing its action, for it is the law repeatedly administered by the supreme court. This court is asked to intervene not for the purpose of correcting any mistake of

law promulgated by the court of appeals, but rather to review the findings of that court concerning the weight of evidence in a voluminous record where the parties were fully heard upon oral arguments and printed briefs, where numerous mechanical exhibits were before the court and considered by it in reaching its finding, and where the petition does not allege any circumstance indicating special hardship or injury.

The facts found in the opinion justified not only the decree under the Kitselman patent of which the petitioner complains, but a decree under the Davisson patent as well, and it would appear that the reason why the court did not consider so much of the appeal as related to the other patents in controversy was that it regarded the relief under the Kitselman patent as relieving it from the obligation to review the finding relative to them. If this cause were to be transferred to this court for review, the complainants below, believing that they are entitled to the decree asked under the other patents, would ask the right to a review of all the matters involved in the appeal and for a judgment for the complainants under all the patents in suit to the full extent asserted by the appeal and assignment of error in the court of appeals. But the Kitselman patent expires within the time likely to elapse before this case could be disposed of if brought here, and the Davisson patent has expired. The petitioner (defendant below) is shown by the record to be incorporated with an insignificant capital (probably mainly represented by worthless patents), and it does not appear whether it has any assets upon which execution could be satisfied. It has reported to the master that it discontinued business more than a year before the decision of the court of appeals, and that its expenses in connection with the infringement exceeded its income by more than twice the amount of its capital stock. The prolongation of this litigation throughout the term of the Kitselman patent, liable to result if a *writ of certiorari* were issued, would involve expense and delay for which there is no assurance that adequate compensation could be had in the satisfaction of judgment against a defendant of doubtful responsibility. Respondents, therefore, insist that the circumstances exhibited in the petition are not such as to justify the issue of the writ. If the case were to be reviewed, they would insist that the review should include so much of the action of the court below as was adverse to them, and that they should be awarded all the relief under each of the patents in suit to which they were entitled upon the record below.

ABSENCE OF CONDITIONS ESSENTIAL TO JUSTIFY WRIT.

There is a glaring contrast between the showing made by this petition in this case, which seeks a review of a decision on an interlocutory decree, and the conditions stated in the opinions of this court as essential to maintain such a writ.

In *Am. Construction Co.* v. *Jacksonville Railway*, 148 U. S., 372, this court, after referring to the fact that power to issue such a writ had "been held to be a branch of its jurisdiction which should be exercised sparingly and with great caution and only in cases of peculiar gravity and general importance or in order to secure uniformity of decision," citing *Lau Ow Bew's Case*, 141 U. S., 583, and 144 U. S., 47, and *In re Woods*, 143 U. S., 202, added (*p.* 383):

> "Accordingly, while there have been many applications to this court for writs of *certiorari* to the Circuit Court of Appeals under this provision, two only have been granted: the one in *Lau Ow Bew's Case*, above cited, which involved a grave question of public international law, affecting the relations between the United States and a foreign country; the other in Fabre, Petitioner, No. 1237 of the present term, an admiralty case, which presented an important question as to the rules of navigation, and in which the decree of the Circuit Court of Appeals for the Second Circuit reversed a decree of the District Judge, and was dissented from by one of the three Circuit Judges; and in each of those cases the Circuit Court of Appeals had declined to certify the question to this court.
>
> "There are much stronger reasons against the interposition of this court to review a decree made by the Circuit Court of Appeals on appeal from an interlocutory order, than in the case of a final decree. Before the act of 1891, as has been seen, no interlocutory order was subject to appeal, except as involved in an appeal from a final decree. The only appeal from an interlocutory order under the act of 1891 is that allowed by section 7 to the Circuit Court of Appeals, the same court to which an appeal lies from the final decree. The question whether a decree is an interlocutory or a final one is often nice and difficult, as appears by the cases collected in *Keystone Co.* v. *Martin*, 132 U. S. 91, and in *McGourkey* v. *Toledo & Ohio Central Railway*, 146 U. S. 536. Whether an interlocutory order may be separately reviewed by the appellate court in the progress of the suit, or only after and together with the final decree, is matter of procedure rather than of substantial right; and many orders made in the progress of a suit become quite unimportant

by reason of the final result, or of intervening matters. Clearly, therefore, this court should not issue a writ of *certiorari* to review a decree of the Circuit Court of Appeals on appeal from an interlocutory order, unless it is necessary to prevent extraordinary inconvenience and embarrassment in the conduct of the cause."

In refusing to review an alleged error of the court of appeals, this court said (*pp.* 385-6) that if the court erred—

> "the error was one in the judicial determination of a case within the jurisdiction of that court, and neither so important in its immediate effect, nor so far reaching in its consequences as to warrant this court in undertaking to control the case at this stage of the proceedings."

In the case cited from 143 U. S., 202 (*In re* Woods, petitioner), there were questions of law of considerable importance and there was a judgment for a substantial sum; but this court refused to issue the writ, saying (*p.* 206):

> "But we do not regard the inquiry as to whether it was settled law in the State of Minnesota that a judgment of dismissal in a former suit, such as pleaded here, was not a bar to a second suit upon the same cause of action, or whether the law in respect of recovery by a servant against his master for injuries received in the course of his employment was properly applied on the trial of this case, as falling within the category of questions of such gravity and general importance as to require the review of the conclusions of the Circuit Court of Appeals in reference to them."

Chicago & Northwestern Ry. Co. v. *Osborne*, 186 U. S., 364, seems to treat the fact that the decision below was on an interlocutory decree as conclusive against issuing the writ, citing as authorities *Rice* v. *Sanger*, 144 U. S., 197, and other cases to similar effect; and if *Am. Const. Co.* v. *Jacksonville Ry. Co.* concedes the power it does not encourage its exercise.

In *The Conqueror*, 166 U. S., 110, it is cited as having settled that the writ is ordinarily only issued after a final decree in the court of appeals. (*P.* 113.)

In *Charles Pope Glucose Co.* v. *Chicago Sugar Refining Co.*, 170 U. S., 705, there appeared to be much stronger grounds for granting the petition than in the present case. The decision dismissing the bill in the circuit court had been overruled by two judges in the

court of appeals, the third judge delivering a very vigorous dissenting opinion, holding that the patent which was sustained by the majority was invalid. His opinion was, therefore, affirmatively and strongly shown to coincide with that of the circuit court, which had dismissed the bill on that ground. The petition for writ of *certiorari* charged error of law, and further, that the decision affected very large interests of the petitioner and inflicted very serious and far-reaching damage, the extent of the business interrupted and the heavy damage to the defendant being specifically set forth. This court denied the writ of *certiorari*, plainly indicating that the mere fact that one of the judges in the circuit court of appeals agreed with the court below was not, by itself, a sufficient reason for the issue of the writ, even where large interests of a private corporation were affected.

In the present case, the petition neither charges that the case is one of peculiar gravity and general importance, or that the interposition of this court is necessary to secure uniformity of decision, or any circumstance from which either of these conditions can be inferred. The judgment is interlocutory, and it does not appear that the petitioner has exhausted its remedy. It is not shown that any application was made to the court to certify any question of law to this court, or that any special hardship is inflicted, or liable to be inflicted, upon the petitioner. The dissenting judge did not indicate his reasons for dissent. It is not even alleged that the circuit court has misrepresented or misstated the law in any particular.

Whatever weight may be attached to a dissenting opinion *where the dissent indicates a conflict on a question of law in which the dissenting judge agrees with the lower court on some legal propositions which the majority of the court of appeals overrules, and where the question of law involved is a novel one upon which this court has never expressed an opinion, and of "peculiar gravity and general importance,"* the mere fact that one of the circuit judges records his dissent to a judgment overruling the court below does not, in the absence of such conditions, constitute, by itself, adequate reason for issuing the writ. It does not appear from the petition that there was any dispute on any proposition of law, or that any novel proposition of law was announced or applied in the decision. The law stated in the opinion of the majority is so well settled by the decisions of this court that there is no occasion for it to issue this writ for the purpose of settling the law upon any point touched upon in either the opinion of the court of appeals or the opinion of the circuit court. The real complaint is not that the court misunderstood the law, but that in reviewing conflicting evidence, including numerous mechanical exhibits and expert and other testimony, in the light of the law already expounded by this court, it found the facts against the petitioner in re-

spect to one of the four patents involved in the suit. This court is asked to resolve itself into a jury to try issues of fact and ascertain whether the court of appeals correctly found those facts, and this in a case where jurisdiction of the court of appeals is not questioned, and where it is not alleged that the petitioner has suffered, or is liable to suffer, any hardship, or more than nominal damage.

If it had been intended to have this court review every case in which the circuit court was overruled by the court of appeals and the dissent of one of the judges of the latter court noted (without reference to whether it appeared that there was any grave question of law in dispute between the several judges), this would probably have been made a statutory ground of appeal. But it was not. It was plainly not the intention to burden this court with cases other than those involving new questions of law of special gravity and importance, or affecting something more than ordinary and insignificant private interests.

FIRST ASSIGNMENT OF ERROR FRIVOLOUS.

While the petition purports to rest on the fact that the court of appeals reached a different conclusion from the circuit court and that one of the three judges of the court of appeals noted a dissent, the first assignment of error relates to a question of fact upon which there was apparently no difference of opinion among the four judges and concerning which the court has neither stated nor applied any novel point of law whatever, a fanciful misinterpretation of the evidence which the petitioner contends for but did not persuade either judge to adopt or even dignify by any reference to it, and concerning which, if the petitioner really believed any injustice has been done or is liable to be done, there was abundant opportunity for relief in the court below. If the petitioner supposed the court had overlooked any fact in the record, there has been the amplest opportunity to call the attention of the court below to that fact. If the court is supposed to have misunderstood the law on this point, the petitioner has had the fullest opportunity to call its attention to the law. It is not alleged, and cannot be alleged, that the court has laid down or applied any novel or unusual or improper rule of law, or that the interposition of this court either to settle a disputed question of law of peculiar gravity and importance (or any disputed question of law), or to shield the petitioner from special hardship.

It is not even represented in the petition that the petitioner supposes, or has any reason to suppose, that complainants have ever parted with any title or right under the patent in the territory where the infringing machines are alleged and proved to have been manu-

factured and sold, or in the territory to which the infringing machines were afterwards shipped or in which they were used, or that the complainants have parted with complete title in the patent in any territory whatever, nor is it pretended that defendants ever acquired any right or license anywhere. If on the accounting it should appear that the complainants had granted any rights in any territory to which any of the infringing machines were shipped, and that this ought to have any effect upon the measure of recovery upon such machines, the petitioner has the fullest opportunity to show such facts upon the accounting, and the court can give, and so far as appears will give, the proper weight to any such facts. The inference which the petitioner seeks to draw from the record in support of this point is so inconsistent with the record that neither of the judges below had any occasion to discuss, or did discuss, any question of law touching it. Apparently, all four judges considered the record as so plainly excluding the defendant from disputing the sufficiency of complainants' title that they concurred in regarding it unnecessary to discuss the question.

The bill of complaint showed that the Kitselman patent was granted directly to the complainants, one as patentee and the other as assignee of a fractional interest (*Transcript, p.* 4); and that complainants had, during and since the year of its grant, been extensively engaged in manufacturing, advertising and introducing the patented machine,

> "having been throughout the exclusive manufacturers thereof until the infringement of these defendants hereinafter complained of (except one instance where an infringement being started your orators brought suit, and said infringement was promptly discontinued, and one other where infringement being started your orators gave notice of their rights, and the said infringement was thereupon discontinued); that they have retained throughout the ownership and exclusive control of said letters patent, and each of them, except that they have granted in certain localities rights to sell and use said inventions under some of said letters patent (such grants, however, not including the territory in which the above mentioned defendants have been and are carrying on the infringement hereinafter complained of, in which said territory your orators hold exclusive right under said letters patent in all respects)." (*Pp.* 7-8.)

It then (*p.* 9) charges the defendants with infringing the several patents

> "at Kokomo, Indiana, and elsewhere in the United States,

> . . . by manufacturing at said Kokomo, Indiana, and selling and putting into use there and elsewhere in the United States, wire fabric machines copied after your orators' aforesaid machines and embodying in all said machines the inventions embraced and secured in and under said letters patent, respectively."

It further charges that the defendant company was organized for the purpose of this infringement by men who had been employed by complainants in the manufacture of their machines, and others employed in and about their place of business, and thus made familiar with the patented machine and complainants' rights thereunder.

All these allegations are sustained without conflict by the proofs. (*See Kitselman patent, p.* 535; *dep. Kitselman, p.* 123, *A.* 6-26; *p.* 137, *A.* 94-97; *Stipulation, p.* 32.)

The answer admits the Kitselman patent to have been granted directly to complainants (*p.* 16) and does not allege any subsequent assignment thereof, or that the complainants have ever parted with any rights thereunder in the territory where the defendant's manufacture is alleged and proved to have occurred, nor is there any evidence which could support such an issue if it had been raised. The answer does allege that the defendants have sold rights to manufacture, sell and use machines under some, if not all, of the patents in suit (not the exclusive right), and that they have parted with interest therein in some territory (not the territory where the manufacture is alleged and proved to have occurred), and avers that—

> "many, if not all, of the machines made and sold by the defendant company which are complained of in the bill of complaint herein have been for use in territory which the complainants have sold under some, if not all, of said letters patent, and in respect to which they have no right or interest whatever in respect to said letters patent so sold as above explained." (*P.* 19.)

If this allegation were proved (and it is not), it would not affect the interlocutory decree, since it would be no justification of the infringement (committed by the manufacture and use in territory in which it is neither alleged nor proved that complainants ever granted any rights) that some of the machines, or all of the machines, were sold for use in territory in which the complainants had parted with some, or even all, of the rights under the patents. The opinion and judgment of the court of appeals does not touch (and had no occasion to) upon the question whether, if it appeared that any machines were sold in such territory, the defendants would be relieved

in whole or part from damages in respect to such machines, nor is there any evidence that complainants have parted with any right whatsoever in any territory in which these machines were sold.

Where the patent was admitted to have been exclusively vested in the complainants, an infringer who claims no right under such patent, and who does not either allege in answer or prove in evidence any impairment of that title in the territory where the infringement is alleged and proved to have been committed, cannot expect the court to imagine a defeasance of title within that territory. If such an issue had been made, and evidence had been produced to sustain it, the only effect would have been to require the joinder of such parties as had acquired exclusive rights under the patent in the territory where the infringement had occurred. These defendants had peculiar opportunities for knowing the fact, if there had been any right granted in any territory to which the infringement had extended, and of proving such fact, if it existed. After once admitting the grant of the patent to the complainants the burden was upon them to prove this if they expected to avoid liability for infringement. Complainants are not obliged to prove a negative, or to load down records of this kind with evidence concerning local grants that have no relevance to the question of infringement or to the territory in which the infringement is alleged and proved to have occurred.

Defendants, in the cross-examination of Kitselman, showed (as alleged in the bill) that complainants had granted some local licenses to sell and use under that patent (not in the territory where the infringing manufacture occurred); and that, in some instances, these licenses may have included a right to manufacture (not the exclusive right to manufacture); that they were mere licenses, but exclusive for the locality to which they referred *so far as the right to sell and use* were concerned, and this was true of any which included the right to manufacture. (*P.* 131, *X-Qs.* 52-57.) But it did not appear either that any of these licenses carried exclusive right to manufacture for any territory, or that they carried any right of any kind in the territory where the infringement was alleged and proved to have been committed, and it did appear that no licensee ever manufactured and that the complainants have been the exclusive manufacturers throughout and prepared to supply the entire market. (*P.* 123, *A.* 6-20; *p.* 137, *A.* 94.) The petitioner's brief seeks to treat a mere license which gave the licensee the exclusive right to sell and use in certain territory and included the right to manufacture (not the exclusive right to manufacture) as if it were equivalent to an assignment for such territory. If this were true, it would be immaterial, since there is no allegation or evidence to show that any license was granted for any territory in which the infringement is shown to have occurred. But it is well settled by

the decisions of this court that a license which carries less than the entire title for the specified territory does not operate as an assignment of title or deprive the owners of the patent of the right to maintain suit against infringers in that territory. *Gayler* v. *Wilder*, 10 How., 477; *Waterman* v. *Mackenzie*, 138 U. S., 252. It certainly does not affect the right to maintain suit for infringements committed in territory where no rights of any kind have been assigned and against infringers who have acquired no rights whatsoever under the patent. All that defendants obtained in this testimony was the statement that some local licenses had been granted, some of which were exclusive "so far as the sale and use were concerned;" that some of these licenses may have included a right to manufacture, and that this is true of some of those which carried the exclusive right to sell and use. It is not pretended that any of them carried the exclusive right to manufacture or that any manufacturing was ever done under them. If this had appeared, it would have been necessary for the defendant both to allege and prove that such rights were granted in the territory where the infringement was committed, which it has not done and could not do. Both the circuit court and the court of appeals, with the entire record before them, evidently found the issue which the petitioner seeks to raise under this assignmnt of error so clearly against the defendant as to require no discussion of any question of law relative to it.

REMAINING ASSIGNMENTS SUGGEST NO ERROR OF LAW, BUT MERELY SEEK A REVIEW OF THE EVIDENCE TO WHICH THE COURT APPLIED THE LAW REPEATEDLY ENUNCIATED BY THE SUPREME COURT.

Much that is pertinent here has been said in the opening statement. The second assignment does not correctly state the facts found by the court, but practically charges that the facts shown in evidence are not as found by the court. The third assignment seeks to raise an issue of fact concerning the differences between the defendant's machine and the Kitselman patent, and to challenge the correctness of the finding of the court concerning the substantial correspondence of the several elements of the defendant's machine to the elements described in complainants' patent and recited in its claims. The court has found that each of the elements of these claims was represented in the defendant's machine, co-operating upon substantially the same plan and in substantially the same way as in the Kitselman patent, and with this finding the petitioner is dissatisfied. But this raises no novel question of law and carries no implication that the court of appeals has laid down or applied any new or unusual rule of law. The review asked for would be necessarily a review of the evidence,

and findings based upon evidence, concerning only the parties to this controversy. The fourth assignment also relates solely to a question of fact to be determined upon evidence, and concerning only the parties. Like each of the others, it suggests no question of law requiring adjudication by this court, and no question of any kind of such public interest or general importance as to command the intervention of this court, and no special hardship suffered by or threatened to the petitioner.

The discussion in the brief in support of the petition proceeds upon assumptions and allegations concerning the facts in controversy which do not represent facts conceded to exist, but rather defendant's contentions concerning the effect of the evidence upon matters in dispute—contentions which, for the most part, have been rejected or overruled by the court of appeals and have not the support of any opinion delivered in the case. This discussion ingeniously ignores the real state of facts exhibited in the record and found by the court, and seeks to place upon the evidence an unwarrantable construction. It should not be necessary here to discuss these various assertions or to specify particularly the discrepancies between the petitioner's statement of facts and issues and the facts and issues actually presented in the record and found by the court, for the absence of the conditions necessary to invoke this petition is so obvious that the time of this court ought not to be occupied in reviewing this evidence. But it is due the court of appeals to refer (as I do under subsequent titles) to some of the vital distinctions between the state of facts upon which that court has passed and the fanciful references to them in the petitioner's brief. It will appear that the evidence before it justified the relief given under the law as administered by this court, and that it had no occasion to invoke or apply any novel proposition of law.

KITSELMAN INVENTION.

The brief in support of the petition seems to represent that the Kitselman invention consisted simply in taking an old machine and making it portable, and much of the argument proceeds on this assumption. There is nothing in the record, or in the argument in behalf of complainants below, or in the opinion of the court, to justify such a representation. Some stress has been laid both in argument and in the opinion upon the fact (indisputably established in the record) that the Kitselman invention created the first machine capable of weaving wire-mesh fence in the field or along the posts to which it was to be attached, and the evidence has shown both that this weaving *in situ* gave to the fence a character impossible to be obtained where the mesh was woven in the shop and afterwards hung upon

posts, and that the machine had created a fence distinct in character and possessing substantial advantages over any pre-existing fence, while introducing great economy and convenience in construction and putting into the possession of the farmer the means of building such a fence of greater or less height and with such variety of closeness and style of mesh as special conditions might require and giving to that fence a stability and continuity of tension impossible to obtain in any other way. But it has not for a moment been contended in behalf of complainants, or suggested by the court, that the invention consisted in giving portability to a machine otherwise old, or that the quality of portability, as distinct from the organization of the machine, was the subject of the patent, or that defendant's machine infringed merely because it possessed these qualities or because it effected the same result. Stress has been laid on the fact that the essential plan of construction of all preceding machines was such as to preclude them from being adapted to the purposes of the patented machine and to exclude them from directly building fence along the posts by which such fence was to be supported and its tension maintained, either in shop or field. Stress has also been laid upon the fact that defendant's machine was copied from the Kitselman, element by element, with merely formal changes, and possessed substantially the same mode of operation and performed the same office in the same way. This is quite different from representing that Kitselman had a patent on accomplishing the result, or that defendant's machine infringed *merely* because it was adapted to be used for the same purpose. The stress which is laid upon the peculiar capacities with which the Kitselman machine is endowed, and upon the revolution which it worked in this art, is explanatory of the originality and distinctive value of his invention and of the qualities which are to be considered as material when comparing this machine with the prior art and when comparing it *element by element* with defendant's machine. It does not mean, and has not been treated by the court below as meaning, that the Kitselman patent covers these results, without reference to the presence of the several elements embraced in the Kitselman patent or to the substantial correspondence in the organization of the machines. When reference is made to the fact that the Kitselman machine was the first machine of any kind adapted to weave a mesh fence *in situ*, this does not mean merely that his machine was distinguished from prior ones by possessing the capacity for locomotion, or by being so reduced in weight or bulk as to admit of ready transportation. It is not such changes as these that constitute the Kitselman invention. There was no prior machine which *by any change of proportions, or by providing it with means of locomotion*, could be adapted to such purpose. The entire plan of construction and operation which was fundamental in the prior ma-

chines for weaving mesh fabric (there were no prior machines for weaving wire mesh along the posts) was such as to exclude their adaptation to any such purpose. The capacity and adaptation of the Kitselman machine is due to the discovery by Kitselman that the weaving of such fence could be accomplished by means which dispensed with the complicated and necessarily cumbrous mechanism which, prior to these inventions, constituted the only known mechanical means of weaving wire mesh, and to the construction of his machine on a plan fundamentally distinct from any exhibited in the prior machines or patents. This Kitselman machine is available and valuable for weaving wire mesh in the shop, as well as in the field, and has many advantages over prior machines when used for this purpose. Its avoidance of the complications which were inherent in the plan of prior machines, not merely adapted it to work of which they were incapable, but gave it great advantages over them in the class of work for which they were intended. But in order to appreciate the vital importance of this invention, the far-reaching consequences which resulted from it, and the significance and essentials of the elements constituting it, it must be kept in mind that it brought into existence a machine which had not only the capacity of doing certain things better and more economically than any prior machinery, but the further capacity of doing certain other useful things which no prior machine could do and which had never been done by any means before; that it enabled the farmer to almost automatically weave in permanent position and with permanent tension, applied and maintained as the fence was developed, a stable and peculiarly efficient wire fence, requiring in its construction only such power as could be easily applied by hand; and that there has thus been introduced extensively a new method of fencing at once economical, efficient and conveniently available to the farmer and others—producing a fence that serves a great variety of purposes better than any other that is obtainable within the necessary economic limits. That no prior machine could have been adapted to such purpose by any change short of rejecting the fundamental plan of its construction and contriving an essentially different one, is conclusively shown by the record. That the patentee and his brother (complainants below) starting their little factory at Ridgeville, Indiana, within a few years increased their output of such machines to over 5,000 a year (*dep. Kitselman, p.* 123, *A.* 8) is impressive evidence of utility. Further evidence to the same effect is found in the fact that the defendants, who were personally familiar with this machine and its achievement, combined for the express purpose of competing in the manufacture and sale of one closely copied after it; that defendants do not omit or materially change either of the elements recited in the claims in controversy, or alter their relations to each other, but repro-

duced the entire machine, element by element, with formal changes evidently made for the purpose of disguising the infringement, without introducing any new function or advantage or dispensing with the functions and advantages of the corresponding elements in the patented machine.

One who had never undertaken to weave wire mesh, and never witnessed the operation or studied the art, could have little idea of the difficulties encountered and the complications of machinery which have been resorted to in order to overcome or counteract difficulties which were eliminated by the Kitselman invention. Hence, some reference to these difficulties and the proposed solutions of them by the prior art (including the prior patents selected by defendant's expert as showing the nearest approaches in the prior art) were made as illustrating the departure in conception and construction which distinguish the Kitselman invention, and the difference between aftersight and foresight as applied to this art. The circuit court seems to have misunderstood these references and their object. The court of appeals recognized the fact that Kitselman had created a distinctly new machine, accomplishing a new purpose, and that defendant's machine was composed of substantially the same elements, co-operating in substantially the same way, for the same purpose. It nowhere suggested (as it was nowhere claimed in behalf of complainants) that the patent covered a result independent of the means of accomplishing it, or that defendants infringed merely because they accomplished the same result, or that the departure which Kitselman had made from the prior art consisted merely in such changes as the petitioner's brief discusses.

The nineteenth claim, to which petitioner's brief refers as having been rejected in the Patent Office, does not relate to the elements embraced in either of the claims in suit found to be infringed by the court below; and complainants have not asked or obtained for any claim in suit a construction that would make it equivalent to this nineteenth claim, or approximately so. The question whether the examiner was right or wrong in rejecting the claim has no pertinence to this controversy. Whether he was right or wrong, so long as the claim was stricken out, the complainants are equally excluded from the benefit of it. But they are not (as the petitioner tacitly assumes) excluded from the benefit of claims which were not rejected by the examiner, but were allowed and appear in the patent. Every claim in controversy is in terms limited to elements not embraced in this nineteenth claim, and those elements are present in defendant's machine. The fact that the omitted nineteenth claim, if allowed, would also have been infringed, does not deprive the patentee of the benefit of claims which were granted. The Kitselman invention, as construed by the court, related to the vital organization of the ma-

chine, not to the means of propelling it, and none of the decisions cited by the petitioner on this point have any relevance here.

There is no inconsistency in treating the Davisson invention as a pioneer invention in certain respects and the Kitselman invention as a pioneer invention in respect to other features or achievements. Most of the patents which this court has sustained as pioneer patents have been improvements in an art already old, and have been pioneer in the sense that they introduced some distinctly new advantage, not in the sense of being the first machines falling within the broad art to which they belong. The Davisson invention, as pointed out by the court of appeals and as more particularly pointed out in the testimony of experts, made a fundamental improvement in the loom machine, whereby mechanism that had before been required for taking out the rear twist which was incident to the former methods of weaving was dispensed with, and in this respect was a pioneer invention of great importance. But while Kitselman was able to utilize certain features of the Davisson invention, he created a machine upon a plan distinctly new *in its vital organization.* The Davisson machine was constructed upon a plan not only incompatible with weaving the fence *in situ,* but much less simple and effective than the Kitselman for the purpose of weaving it in the shop, and incapable of the variety or character of work which distinguished the Kitselman. Kitselman utilized the hollow spindle on the projection forward of the rotating gear, with its cross-head and transferable spool-carriers thereon, as the direct agents by which the twist is imparted to the intermeshing wire and by which the machine is also enabled to imbed the longitudinal or warp wires along the central line between the opposing cross-heads, but he contrived a machine in other respects essentially original. The very conception of the possibility and practicability of creating a machine adapted to weaving wire-mesh fence *in situ,* or a machine capable of weaving wire mesh anywhere without the use of the complicated mechanism with which he dispensed, was original with Kitselman. It necessarily involved a distinctly original plan of construction. The spindles of the Davisson machine were arranged vertically and had in the operation of the machine a longitudinal movement which involved driving mechanism of a kind inconsistent with field use and objectionable for shop use, besides consuming power and adding to the cost. Indeed, the structure of the machine generally was neither suggestive of, nor compatible with, weaving a fence along the posts, whether in the field or shop. It was a loom adapted and intended for permanent factory use in the manufacture of wire fabric as an article of commerce. Kitselman, in the preliminary statement of his patent, represents his object to be to provide a simple and easily

operated machine for making twisted wire fabric for use as fencing and analogous purposes

> "which can be adapted for use in the open field or other place for the construction of fences, as well as a stationary or fixed machine for the manufacture of wire fabric.
>
> "A further object of my invention is to provide a machine of the class specified which can be adapted for the manufacture of different classes or designs of wire fabric or fences, when used as either a portable or stationary apparatus, without requiring any adjustment or interchange of its parts."

The qualification for field use, *in addition to* that for shop use, and the capacity to make the wire-mesh fence for which it is peculiarly adapted, with the incidental advantage that it could also be used for making other varieties of fence, are made conspicuous in the patent.

Instead of the vertical, longitudinal, reciprocated spindles of the Davisson patent, Kitselman provided a series of short horizontal spindles arranged in vertical line, and stationary so far as any longitudinal or lateral movement was concerned, so that the cross-heads would be kept permanently in the plane of their rotation instead of being thrust into and withdrawn from that plane between the successive twists. He formed the twisters in three sections, all extending forward from the cross-head and mutually supporting each other concentrically in the line of strain incident to the twisting operation, or, as Mr. See expresses it, in "the twisting zone" or the "plane of aggression." The central sections were fixed in permanent alignment, while each of the side sections was adapted to be supported by the central section when rotating upon it as a center, the three sections forming, during the period of this rotation, a substantially solid twister, severally supporting the three wires in the plane of the twisting action, and, by contact of the faces of the three sections in this plane, offsetting the counter strain incident to this twist. The side sections, when in the arc of rotation which brought them into proper registration, were adapted to slide from the central sections with which they had been in conjunction to the central sections next above and below, the shifting sections on one side of each central section moving to the central section above, while the shifting section on the other side moved to the central section below, the several shifting sections entering into the same relationship with the central section to which they were thus transferred as they had before maintained with the central section from which they departed, the entire movement taking place without any endwise movement of either section and through guides brought into registration with both central and shifting sections when in this arc of rotation.

The three sections, composing for the time a practically solid integral twister, were maintained in parallelism by so forming them that the sections were in engagement, or impinging contact, with each other on the transverse diametrical line taken through the points at which the intertwisting wires exert their stress during the twisting operation, the sections being adapted by their impinging surfaces to engage with each other and mutually support each other against concentric strains, both before and behind the spools. The tendency of the spool carriers to be rocked inward by the concentric pull of the wire on their front ends was thus excluded.

The central sections of the twisters were geared directly with each other in such manner that the rotation of one gear communicated uniform rotation to the series of sectional twisters, alternate twisters rotating in opposite directions, enabling the operator to apply any desired number of twists, and superseding the rack system of actuating the spindles incident to the Davisson construction, which was not consistent with the economy of power and space demanded in a field machine. The entire mechanism was so contrived and combined as to bring it within very narrow compass, and reduce it to great simplicity of structure, at the same time economizing the power required for its operation. It was compactly mounted in a narrow vertical frame, which carried the twisters on horizontal axes in vertical alignment. This frame was provided on one end with trucks or rollers, and provided also with means for advancing it along the ground in the direction of the axes of the twisters by an intermittent motion corresponding to the spacing of the mesh. The sectional construction of the twister, by bringing the central tube in supporting contact with the side sections on the diametrical line taken through the wire supporting openings in the head of each section, neutralized the converging strain upon the reel-carrying sections. The central section, being interposed between the two outside sections in the line where the convergent pull incident to the twisting operation is encountered, transmits directly through that line the opposing forces applied upon the opposite sections, these forces acting always in opposite directions on the line taken through the wire-supporting openings in the front of the three sections. These opposing forces, being approximately equal, offset each other in the plane in which the strain comes, and the spool-carriers are relieved from the converging leverage on the cross-heads which would otherwise result. The elimination of this strain, effected by the sectional construction of the twisters, simplifies the attachment of the spool-carriers to the cross-head, dispenses with the occasion for making them as massive as would otherwise be required, and avoids the tendency to twist the opposing reels or reel-carriers out of parallelism, which, in the absence of the sectional construction, would be mischievous, and might be ruinous if not resisted by a more

ponderous construction than would be consistent with convenient field use. It also prevents deflection of the central wire in the plane of twist, and maintains the two woof wires at uniform distance from the center. The plan of construction thus introduced by Kitselman made a thoroughly practical and highly useful field machine for weaving wire fence, and that plan has been closely adhered to in every subsequent machine for this purpose.

The claims in controversy embrace broadly this machine with its series of sectional twisters, each comprising a central section for carrying a warp wire and having rotary movement imparted thereto, and the shifting sections for carrying the weft wire and receiving rotary motion from a central section to form the twist, substantially as and for the purposes described, some of the claims in controversy specifying additional elements in combination with those here mentioned.

For fuller exposition of this invention, see *dep. J. W. See, Tran., pp.* 290-295, and *dep. M. E. Dayton, pp.* 52-62.

The evidence fully sustains the finding of the court of appeals concerning the novelty and originality of the Kitselman machine and of the fence produced by it. None of the prior machines made, or were adapted to make, such a fence, and it rather adds to, than subtracts from, the value of the machine that in addition to the capacity for making fence that could not be made by other machines, it preserved the capacity of making with great economy varieties of fence that could not be made by prior machines. Apart from other distinctions between the prior loom-made fence and the Kitselman fence, the fact that the Kitselman machine wove the fence upon the posts to which it was permanently attached in process of weaving, so that the tension that was put into the fence in the act of weaving was preserved in the fence as stretched from post to post, gave the fence a character which no fence composed of woven fabric made upon looms and subsequently hung upon posts could acquire. The looms did not make fence, or weave the wire along any posts or supports in such manner that the tension applied in weaving was maintained in the fence, but simply made mesh which lost its initial tension before being transferred to the field, and which could only be hung by hand upon posts after being so transferred, forming an unstable and sagging fence instead of the straight, tense and firm product obtained by Kitselman. Where the fence is thus woven from post to post the tension applied in the twisting of each successive mesh is never relaxed, but remains in the completed fence, a result not obtained either in shop or field before. The effect of this is far greater than would at first be imagined. While it is possible to stretch a rope a few inches at a time, under great tension, until it is substantially straight, it is not possible, by the application of the same tension, or ten times that tension, or any

tension the rope would stand, applied to a rope a hundred yards long, to stretch that rope straight. The single meshes of fence, twisted one by one and rigidly held against recession as they are twisted, can be successively developed into a straight, rigid fence, but the roll of wire mesh, once relaxed from the machinery which forms it and transported in its relaxed state to the place where it is to be applied to the posts, can never be so applied to them as to form a fence approximating in character that which is woven mesh by mesh *in situ*. This and other distinctions have been referred to and pointed out in the testimony heretofore cited.

Kitselman created a *new machine*, utilizing (as most new machines do) some of the old elements so modified as to reconcile them to new associations and conditions and accomplish a distinctly new unitary object. This is all that is necessary to constitute a pioneer invention, and to entitle the patentee to protection in the substance of that invention. A patent for the first successful machine that could travel in the air would not be entitled to a less liberal construction because its organization was such as to enable it also to travel upon the land. Kitselman's patent for a machine which, *by virtue of a different organization from any preceding it*, possesses the capacity to weave wire-mesh fence in the field, which belonged to no predecessor, is no less a pioneer patent, and entitled to no less liberality of construction, because it can be used in the shop as well as in the field, or used for other purposes than those which it was the first to serve. If making any of the old machines portable, *without change in their operative elements or the organization of these elements*, would convert either of the old machines into one that would serve appellee's purpose, appellees should have adopted this expedient instead of reproducing element by element (with changes of form that did not deprive them of their essential character) each of the elements of the Kitselman claims, related and co-operating in substantially the same way to work out the same result. There is nothing in the logic of the court that justifies the charge that the invention for which the Kitselman patent is sustained is merely making an old machine portable. On the contrary, the opinion clearly points out the fact that the invention was of a very different character from this.

INFRINGEMENT.

The court of appeals has not held, and was not asked to hold, that the Kitselman patent covers "all forms of machine for producing the same result." It has found, not merely that the defendant's machine produced the same result, but that it accomplishes it by substantially the elements named in the specified claims (with only such

changes of form as do not deprive them of their essential offices) co-operating with each other in accordance with the plan of the Kitselman patent and working out the same result in substantially the same relation to each other. Mere changes of *form* in the elements, which do not deprive them of their essential character for the purpose of the combination, do not avoid the claims. This has been so repeatedly held by the supreme court that it is unnecessary to cite cases in support of the law administered by the court of appeals. The opinion is not in conflict with that of this court in *Westinghouse* v. *Borden Power Brake Co.*, 170 U. S., 596 (which was discussed by both parties in the court of appeals), but rather applies the law as there stated to a case where each of the elements of the patented device is present in the defendant's machine, with such changes of form and subordinate details as do not deprive them of their essential character. *Westinghouse* v. *Borden Power Brake Co.* does not conflict with the decisions which have held that a patent cannot be avoided by changes in the form of the elements or by improvements in those elements which do not deprive them of their essential character, but while rejecting the contention that similarity in the results in the *machine as a whole* is sufficient to constitute infringement where the several elements recited in the claim are not present or represented by equivalents, reiterated this doctrine. It pointed out the difference between considering the function of the elements in determining whether they were equivalents, and judging the question of infringement solely by the similarity of the result in the machine as a whole irrespective of whether the essential elements that constituted it were either present or represented by equivalents. Defendant's machine in the present case responded both in terms and substance to the claims of the patent under which infringement has been charged, and the differences upon which petitioner's brief laid stress are either imaginary or fanciful or irrelevant to the claims in suit. Defendant's machine, like the Kitselman, has the sectional twisters, each comprising a central section for carrying the warp wire, having rotary movement imparted thereto, and shifting sections for carrying the weft wire and receiving rotary motion from the central section to form the twist, the construction of the individual elements and their relation to each other being substantially such as is described in the patent and for the same purpose, and it has each of the other elements combined with these, as specified in other claims in suit. The central sections and the side sections are in contact on the line taken through the wire discharge openings at the forward end of the three sections, as well as at the rear end, so that the convergent strain upon the side sections is neutralized by the interposition of the central section in the plane in which this strain occurs, the opposing strain upon the two side sections being thereby offset one against the

other through the continuous head formed in the zone of twist. The parallelism of the side sections or shifting sections is thus maintained, deflection on the warp wire in the plane of twist is prevented, the woof wires supported at uniform distance from the center in that plane, and the converging leverage which would otherwise tend to deflect the heads of the side sections toward the center is thus counteracted, as in the Kitselman composite or sectional twisters. Defendant's have given different outlines to the heads of these several sections, taking care, however, to preserve the capacity for continuous support in the diametrical line take through the three-wire apertures, which is the prime object of the sectional construction. The patent under which they claim to manufacture, and under which their machine is marked, lays stress upon this characteristic, saying (*Whitney patent No.* 552,-025, *R., p.* 769, *second column, line* 102):

> "Although the spool-carriers are supported only at the lower end and at some distance from the spools themselves, it will be noted that the wires *g* draw from the aperture in the cross-piece F^5 to the longitudinal strand, in the direction of the length of said cross-piece, and that while the carriers are being transferred and are rotating the end of the cross-piece is against and turns about the tubular extensions D, as seen in Figs. 1 and 2, thereby preventing the carriers from dropping out."

It is by maintaining the axial parallelism of the three sections against the converging strain that the "dropping out" of working position is prevented.

Defendants have changed the shape of these heads or cross-pieces corresponding to F^5 from the outlines exhibited in the patent under which they claim to manufacture quite as much as from the shape exhibited in the Kitselman patent, but have retained this capacity for mutual support, which is the essential purpose of this sectional construction in each case. They are thus enabled, as in the Kitselman patent, to project the shifting sections in front of the cross-head and support them against the converging strain by mutual engagement on the diametrical line, in the zone where the converging strain is exerted.

The three sections form a practically solid integral twister during their rotation, and the side sections, when in the proper arc of rotation (as in the Kitselman), are brought into registration with guiding surfaces, which permits their being transferred at will in a vertical plane (without intermediate longitudinal movement) and brought into the same composite relationship with the central sections above and below them, respectively, with which they establish the same practically integral character during the period of their rotation.

Defendants have availed themselves of the Conner device for automatically switching or transferring the sections, and also of the Pope invention, by which the rotation of the central section is confined to the cross-head, which turns on the spindle as a bearing, this spindle remaining stationary. But these are only superadded improvements which do not conflict with, or deprive the mechanism of, the advantages secured by the Kitselman invention.

Defendants' expert lays stress on the fact that the heads of the several sections of defendant's twisters have not the "segmental" form exhibited in the Kitselman patent, and that the shifting mechanism is not the same. It is a sufficient answer to this, *first*, that certain of the claims of the patent, not charged to infringe, have the additional limitation to "each side section having *segmental* heads," or to "the side sections in contact with the central section and having the *segmental* heads, and with their flat sides in contact with the central sections," such claims being distinguished by these limitations from those here in suit (see claims 14, 16 and 19); *second*, that certain of the claims not charged to be infringed contain the further limitation to the sliding, shifting mechanism; *third*, that the claims in suit are plainly intended to avoid these specific limitations, their omission from these claims being emphasized by the other claims thus contrasted with them; *fourth*, that the prime object of the sectional construction is secured irrespective of whether the heads have the shape illustrated in complainant's patent or that used by defendants. Complainants have confined their charge of infringement to those claims which do not contain these limitations.

The correspondence of the defendant's construction with each of the Kitselman claims in controversy is more particularly explained by Mr. Dayton, *pp.* 57-62, and Mr. See, *pp.* 312-318.

The differences between defendant's machine and the illustration of Kitselman's invention in the patent, dwelt upon in the petition, are either imaginary, or fanciful, or irrelevant to the claims in suit. The shifting in each case is done by a lever, and all the side sections are shifted simultaneously (the two side sections about each central section passing in opposite directions to a vertical plane above and below, respectively, where they come into registration and alignment with the central section vertically above and vertically below that with which they were before registered), and when this vertical movement has taken place the respective side sections form, with the central sections above and below, solid three-part twisters rotating about the axes of the central section, precisely as in the Kitselman patent. If, as appellees insist, it be possible to take the side sections of the Kitselman out of the machine and insert them in reverse position (that is, with the front end toward the rear), this is never done in operation. There is no object in doing it, and if done it would have

no effect whatever. It is not referred to in either claims or specification, and is purely a question of form, not affecting the character or performance of either part.

There are other claims which include in terms the particular shifting mechanism shown in the Kitselman patent, which are not included in the charge of infringement. The claims in suit obviously omitted these limitations and were allowed without them because the invention was not confined to such shifting mechanism, the subject-matter of these claims being original irrespective of the construction of the shifting agent. In each case the side sections are moved vertically in opposite directions from one central section to the other during intervals between the twisting operation, without endwise motion, register with the several central sections successively, and revolve during the twisting operation in registration and alignment with them about an axis taken through their center.

OPINION OF THE CIRCUIT COURT.

The opinion of the circuit court apparently assumes that because the Kitselman patent is entitled as for an improvement in the art to which it relates (the formula adopted by the patent office, irrespective of the originality or scope of the invention), it follows that it cannot be a pioneer patent or entitled to the benefit of the doctrine of equivalents. Every patent that has been sustained by this court as a pioneer patent has been entitled as for an improvement in the art to which it relates, and most, if not all, such patents have represented some departure in an art in which there were numerous prior patents. The opinion of the circuit court also seems to assume that because the defendant has a license under a later patent, it cannot be held to infringe unless the later patent is assumed to be invalid, and that the issue of that later patent implies the opinion of the patent office that the defendant's structure is not an infringement. Such an assumption is plainly excluded by the decisions of this court. The patent office in granting a subsequent patent, is not concerned with the question whether the machine exhibited in that patent would infringe a prior patent. If that machine exhibits any patentable addition or improvement (even though it retains bodily the entire invention of a prior patent), the patent office is as much bound to grant the subsequent patent as if the prior patent did not exist. The sole question for it is whether the subsequent patent exhibits anything patentable not found in prior patents, not whether it includes what is found in them. Most valuable patents are immediately followed by subsequent patents which retain the essential features of the earlier patents and incorporate upon them improvements

which are claimed in connection with the machine upon which they are incorporated.

In nearly every case where this court has sustained a patent and found infringement, the defendant's machine has been made under a subsequent patent, and this court has frequently recognized the validity of such subsequent patent while holding the mechanism made under and in accordance with an infringement of the prior patent.

See

Clough v. *Barker*, 106 U. S., 166, and simultaneous decision in *Clough* v. *Mfg. Co.*, 106 U. S., 178.
Hobbs v. *Beach*, 180 U. S., 383 (398).
Dubois v. *Kirk*, 158 U. S., 58 (63).
Cons. Valve Co. v. *Crosby Valve Co.*, 113 U. S., 157 (167).
Morley v. *Lancaster*, 129 U. S., 263 (265).
Hoyt v. *Horn*, 145 U. S., 302.
Keystone Mfg. Co. v. *Adams*, 151 U. S., 139 (145).
Cochrane v. *Deener*, 94 U. S., 780 (782).

The circuit court seems to have entirely misunderstood the Kitselman patent and machine and the defendant's machine. It dwells upon differences in respect to features not relevant to the claims in suit and not affecting the operation of the elements named in those claims, some of them features which are the subject of other claims not charged to be infringed. It lays stress upon differences in the specific construction of the shifting mechanism, differences which are not relevant to either of the claims in controversy, and which are immaterial, so far as the operation of the elements enumerated in the claims are concerned. There are claims which relate to some of these specific features and which, for that reason, are not charged to be infringed. It is enough that the elements named in the claims in suit are present in the defendant's machine (with only such changes of form as do not deprive them of their essential character), co-operating to perform the same office. This office is not changed by the fact that the spool carriers take a circuitous instead of a direct path in traveling from one twister to the other. The object of the transfer (whether made in a straight path or a curved path) is to bring one outside section of each composite twister into circuit with the central section above and the other outside section of the same composite twister into the circuit of the twister below, and it makes no difference whether in passing from the one circuit to the other the travel is on a straight line or a curved line. In either case, the transfer of one section is into the orbit below, and of the other, into the orbit above, and the shifting in one case serves identically the same purpose as the shifting in the other. As a matter of fact, the shifting in each

case is effected by a hand lever, which in defendant's machine is in the form of a crank, while in the drawing of the patent the hand lever illustrated as doing the shifting has a different shape. Neither of the claims in controversy is limited to any particular mechanism for making this shifting, though, of course, some shifting agent to transfer these elements at the proper interval from the twister-head below to the twister-head above, and *vice versa,* is necessarily present in each case. In each case the parts to be transferred must be in registration when the transfer takes place, and the spool-carriers (which are in each case the outside sections of the twister-head) are transferred simultaneously, one to the twister above, the other to the twister below, for the same purpose and with the same effect.

In each case, a single movement of the lever-arm (which in defendant's is a crank-arm) shifts one of the side sections or spool-carriers of each twister so as to bring it in conjunction with the complemental side section or spool-carrier which has before been rotating as a member of the twisters above or below it. In each case, enough of the central section revolves to perform the office of the cross-head and impart rotation to the side sections. In each case, the rotation is on the same axis, and the claims are not concerned with the question whether the spindle rotates with the cross-head or serves as a journal on which the cross-head rotates. In each case, the same gear applies the same rotation of the central section around the same axis in the same relation to each of the parts, for the same purpose as in the Kitselman patent. In each case, the shifting of the spool-carriers is effected by a hand lever, though in one case that hand lever has the form of a crank, and in the other a different form. There is nothing in the claims that requires the spool-carriers to be supported either at both ends or at one end only. As a matter of fact, they are supported in each case at both ends. In neither case are the spool-carriers taken out and turned end for end, nor are the claims in any way concerned with a capacity for doing so. In each case the hollow spindles are made stationary in the sense required by the Kitselman patent (that is, maintained in fixed relative position in alignment with each other and on the same axial center, while the other members of the twister are shifted). In neither case would the capacity of the hollow spindles be destroyed by leaving the tubular portion stationary. In each case, it is equally necessary to rotate enough of the central portion to impart the necessary movement to the adjacent side sections. In each case, the segmental ends of the side sections of the twister make, with the lateral end pieces of the central sections, wheels at the ends of the twisters which rest in supports which permit their rotation, in each, the engagement and mutual support of the three sections is at both ends, and in each the purpose and effect is the same, though the defendants have disguised the wheels at the outer end by changing

the shape while carefully preserving their office. In neither case can the spool-carriers be transferred, except when the parts have been brought to a position of rest in a fixed alignment and the movement of the pinions arrested. There are differences in the mechanical devices for affecting the transfer, which are the subject of later patents sued upon, but with these differences in the shifting mechanism the Kitselman claims in suit are not concerned.

ORIGINALITY AND NOVELTY OF KITSELMAN INVENTION.

The radical departure made by the Kitselman invention has been indicated under the title of "Kitselman Invention." That this invention created a new type of machine, adapted to purposes of which no preceding machine was capable, is strikingly illustrated by the fact that defendant's expert selected as the nearest approach to the Kitselman patent in the prior art (*dep. Wiles, p.* 229, *X-Q.* 21) the Nesmith patent, which is so totally unlike the Kitselman that defendants, when introducing in evidence a model designated as representing the Nesmith machine, omitted from that model all the part of the Nesmith machine which was designed to weave the wire fabric (the machine being a loom machine for the purpose of weaving such fabric in the shop), and included in their model only those parts of the Nesmith machine provided *for the purpose of taking out the rear twist* which was incident to the weaving mechanism of the Nesmith machine and *which is entirely excluded by the weaving mechanism* of the Kitselman machine, so that the untwisting mechanism represented by defendant's Nesmith model is dispensed with altogether by Kitselman. If Nesmith had conceived the possibility of weaving by the means employed in the Kitselman patent, and covered by the Kitselman claims, he would have had no occasion for any part of the complicated mechanism represented in the model introduced by defendants, or for the weaving mechanism shown and described in his patent as the means for such weaving as his machine purports to be capable of. Defendants propose to convert the mechanism which in the Nesmith machine was required for the purpose of taking out the rear twist, incident to Nesmith's weaving mechanism, into weaving mechanism operated upon a plan absolutely excluded by the Nesmith patent and which it is plain Nesmith never conceived of. Defendant's method of attacking the novelty of the Kitselman patent is to undertake to reorganize old machines on a plan inconsistent with and not suggested by the plan upon which they were constructed or exhibited in prior patents, omitting parts and supplying others, to adapt such as are retained to offices which they were incapable of performing in the relations which they sustained; to show how, with the

plan of the Kitselman patent before the expert, parts of the old machines could be brought into new relations (with such modifications in their structure as could easily be made when the plan or reorganization was conceived of); and to insist that there was, therefore, no invention required to create the new machine. Instead of obtaining a certified model of the Nesmith machine from the patent office (which would show that the weaving mechanism of that machine bore no resemblance to that of the Kitselman), defendants constructed the model introduced in evidence under the name of "Defendant's Exhibit Nesmith Model," which was made the basis of defendant's expert testimony concerning that machine. In making this model for the purpose of an exhibit in this case, care was taken, *first*, to omit from it all that part of the Nesmith machine by which the twisting into mesh was effected; *second*, to remove the feeding mechanism from its relation to other mechanism, which, in the Nesmith machine, excluded it from *applying* any twist to the wires and confined its operation to *preventing* twist in them; *third*, to incorporate in it features which were not shown or described in the Nesmith patent and which are inconsistent with what is shown and described there; *fourth*, to alter parts of the machine which are shown and described and which excluded the operation which, for the defendant's purpose, it was desirable to incorporate in the model, thereby giving the model a theoretical capacity which this mechanism did not have in the Nesmith patent; *fifth*, to ascribe to the model thus reconstructed a capacity dependent upon its being brought into direct cooperation with suitable mechanism for resisting the twist immediately in front of the gear illustrated in the model, and for drawing the wire through such gear when thus held in opposition to such rotation —a plan absolutely irreconcilable to the Nesmith patent. (*See, in this connection, dep. See, Trans., pp.* 283-288, 297-8.) Even with such changes, plainly governed by a purpose to give the model as much resemblance as possible to the patents involved in this suit, it was still impossible to convert the machine into one which would at the same time possess any resemblance to any part of the Nesmith and correspond either in elements or in plan of construction or mode of operation or capacity with the Kitselman. Complainants, in rebuttal, produced a certified copy of the Nesmith model which was before the court of appeals, and effectually disposed of the argument of defendant's expert. (*Dep. See, pp.* 324-5, *A.* 11.) Similar liberality has been exercised by the defendants in referring to other prior patents or provisional specifications, and in undertaking to construct out of them (by applying elements or modifications which are neither shown nor suggested in them), something that would be of service in attacking the novelty of the Kitselman invention. The depositions of Mr. See and Mr. Dayton explain sufficiently the distinctions be-

tween the Kitselman patent and each of the prior patents or machines referred to in defendant's testimony, and I cite the depositions of Mr. See (*pp.* 290-303) and Mr. Dayton (*pp.* 382-398, *also, pp.* 245-290) as containing all that it is necessary to say concerning the prior art.

CANADIAN DECISION.

Petitioner's brief refers to a Canadian decision in *Risdon* v. *Cochrane*. This was a suit on a patent taken out by Kitselman in Canada and assigned to Risdon. Neither of the parties to the present suit was privy to that, and the defendant's machine in that case was a different machine from the defendant's in the present case. The patent was issued under a different law. The opinion (which related solely to the question of infringement in that case) was evidently that of a court of original jurisdiction, a stranger to the subject of patent law, and indicates plainly that the law there administered (whether it correctly represents the Canadian law or otherwise) was completely at variance with the law applied to such cases by the supreme court of the United States. The Canadian opinion does not touch upon the question whether the defendant's machine contained subject-matter of either of the claims of the patent in suit but proceeds upon the assumption that if the machine which that plaintiff was building under the patent differed from defendant's either in framework or in shape, or in the strength or thickness or size of the working parts, or if the defendant had introduced into his machine any improvements over the plaintiff's machine as built, or had "rearranged" the machine, or if the defendant's machine was of a better mechanical construction, or contained fewer parts (not in respect to the elements embraced in the several claims, but in respect to the framework or actuating parts or other subordinate incidents of the machine), there could be no infringement. It assumes that the question was whether the defendant had a valid patent, and if so, that was conclusive against infringement; that if the defendant's machine, as constructed, was in any respect better than the patented machine, as constructed by the plaintiff, that was fatal to the charge of infringement, though the differences were only in the size and strength of the parts. It dwells upon the differences in the strength of the supporting frame; the difference in the mechanical means of attaching the spools; the fact that the central shaft of defendant's machine "had three bearings, so that it was stronger than in the plaintiff's machine;" that the wire passing through the central shaft "goes through a thicker tube than in the plaintiff's;" that "there is greater weight in the defendant's machine, and, therefore, a greater strength;" that because de-

fendant's machine was four inches taller than the plaintiff's, "a fence four inches higher can be made," and, from such premises, concluded that "the defendant's patent is a good patent," and treated this as equivalent to holding that there was no infringement. There is in the opinion no reference to the claims of the patent or to the terms of the patent, or any effort to distinguish the elements upon which the claims are predicated from structural features of the machine upon which they are in no wise dependent—no reference to the *invention* embodied in the patent, as distinguished from such mechanical details in the construction of plaintiff's and defendant's machine as those above mentioned. Apparently the court understood that the comparison was to be, not between the defendant's machine and the claims of the patent in suit, but between the entire mechanical construction used by the plaintiff (including quality of workmanship, strength and size of parts, etc.), and the entire mechanical construction used by defendant, and if defendant's machine was better in any of these respects, or contained any supplemental improvements, that excluded infringement. The opinion throughout was in direct conflict with the controlling decisions in this country. The question of infringement under our law does not depend upon whether the plaintiff builds a better or a worse machine than the defendant, or whether the defendant has or has not improved the machine either in its mechanical construction or by supplemental invention. It is probable that this decision is no just exponent of the Canadian law, and it would seem probable that neither the judge who delivered it, nor the counsel who presented the case, had any familiarity with the decisions of the higher Canadian court, or any other bearing upon this subject. But whether it correctly represents the law there or not, it has no effect upon the law here, and was not dealing with the same patent or the same parties or the same question of infringement. Certainly this court cannot undertake to issue a writ of certiorari in every case where the opinion of the circuit court of appeals fails to conform to an opinion of a Canadian court of common pleas in a case arising under a different franchise, dealing with a different question of infringement, and concerning different parties.

SUMMARY.

The petition shows none of the conditions necessary to justify the intervention of this court and should be denied.

Respectfully submitted,

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